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Paper No. 17
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Computer Systems Authority, Inc.

Serial No. 75/191,176

Kay Lyn Schwartz of Gardere & Wynne, L.L.P. for Computer Systems Authority, Inc.

John E. Michos, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Cissel, Quinn and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On November 1, 1996, Computer Systems Authority, Inc., (a Texas corporation), filed an application by which it seeks registration on the Principal Register of the mark CSA for services identified in the application, as amended, as "computer services, namely consulting services specifically relating to implementation and technical support of existing major applications currently on the market" in International Class 42. The claimed date of first use and first use in commerce is August 30, 1996.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with its identified services, so resembles the registered marks CSA¹ and CSA/GENSA², both owned by Computerized Structural Analysis & Research Corporation (a California corporation), and both for "computer software design for others; updating of computer software; and computer consultation" in International Class 42, as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant filed this appeal. Briefs have been filed, but an oral hearing was not requested.

We turn first to a consideration of the marks. One of the cited registrations (Registration No. 2,091,257) for the mark CSA and applicant's mark are identical.³ This fact "weighs heavily against applicant." In re Martin's Famous

¹ Registration No. 2,091,257, issued August 26, 1997, (from an application filed September 16, 1996). The claimed dates of first use and first use in commerce are April 1, 1982 and April 25, 1985, respectively.

² Registration No. 2,050,894, issued April 8, 1997, (from an application filed May 13, 1996). The claimed dates of first use and first use in commerce are December 1995 and January 24, 1996, respectively.

³ Because applicant's mark is identical to one of the cited registrant's two marks, we need not reach the question of whether there is a likelihood of confusion between applicant's mark and the cited registrant's second mark, "CSA/GENSA."

Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). Indeed, the fact that an applicant has selected the identical mark of a registrant "weighs [so] heavily against the applicant that applicant's proposed use of the mark on "goods...[which] are not competitive or intrinsically related [to registrant's goods]...can [still] lead to the assumption that there is a common source." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688-1689 (Fed. Cir. 1993). "The greater the similarity in the marks, the lesser the similarity required in the goods or services of the parties to support a finding of likelihood of confusion." 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §23:20.1 (4th ed. 1999).⁴

Moreover, there is no evidence that the combination of the letters CSA (even if derived from the initial letters of the applicant's and registrant's respective corporate names) have any special meaning, aside from trademark significance, to purchasers of the involved services. CSA is unpronounceable except as the separate letters, and would be more difficult to remember, and thus, more

⁴ Applicant cited several cases wherein the Board (or a Court) found "identical" marks would not result in a likelihood of confusion. Suffice it to say that each of the cited cases is easily distinguished on its facts (for example, the marks were not identical, with some including designs, and/or there were differences in the goods/services, and/or consent agreements were involved, and/or the cases were inter partes in nature).

susceptible of confusion, or mistake. See Weiss Associates, Inc. v. HRL Associates, Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (confusion found likely in contemporaneous use of TMM and TMS on computer software).

Applicant's argument that the cited registrant's marks are entitled to a narrow scope of protection, based on the results of applicant's search of a private database⁵ showing fourteen active federal marks which consist of or include the letters CSA, is unpersuasive.⁶ Regarding the fourteen listings submitted by applicant, two are pending trademark applications (one of which is applicant's involved application), and are of no probative value. Applicant's listing also included one of the two cited registrations. As for the eleven third-party registrations for marks consisting of or including the letters CSA, all are for unrelated goods/services such as, wholesale distributorships featuring exercise equipment; clothing; jewelry; inflatable mattresses for camping; surgical suite

⁵ While normally the records from a private database are not admissible [see *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992)], because the Examining Attorney has treated them as of record, the Board has considered the third-party registrations in our decision.

⁶ Applicant also argued that this evidence shows the cited registrant's marks are not "famous." We disagree that a search shows whether a mark is or is not famous. Inasmuch as there is no evidence of the fame of the cited registrant's marks, this du Pont factor is not relevant in this ex parte record.

and clinical laboratory instruments; underwriting insurance services; custom designing construction projects for others; publications concerning industrial, commercial and domestic technical standards⁷; and a certification mark for the safety of electronic goods. Applicant did not submit any third-party registrations of the mark CSA in the relevant field of computer consultation services. And, in any event, third-party registrations are of little weight in determining likelihood of confusion as they are not evidence of third-party use of the marks shown therein and they are not proof that the purchasing public is familiar with them so as to be accustomed to the existence of similar marks in the marketplace.

Even if applicant had shown that the cited mark CSA is weak, such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or related goods. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976).

We turn to a consideration of the cited registrant's services and applicant's services. Applicant contends that "the services marketed in connection with Applicant's mark

⁷ We note that this registration issued based on Section 44 of the **Trademark Act**, not on use in commerce.

are distinctively different from those services marketed by the cited Registrant..." (brief, p. 8); that "the very specialized nature of the registrant's and the Applicant's respective services indicates that they are marketed to very specific and different purchasers through generally different channels of trade" (brief, p. 10); and that "the actual services offered by Applicant are quite different from the services offered by Registrant, and are directed to a different class of consumers" (brief, p. 10). Applicant offered no evidence thereof.

It has been repeatedly held that when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the Board is constrained to compare the services (or goods) as identified in the application with the services (or goods) as identified in the registration. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Applicant's identification of services is specific in that its computer consultation services relate to

"implementation and technical support of existing major applications currently on the market." However, the cited registrant's identification of services includes no restrictions and of course registrant's broader "computer consultation" services would encompass those offered by applicant. We find that the respective services, as identified, are overlapping because applicant's services are included within registrant's services.

In any event, it is well settled that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods or services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the goods or services. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Here there is no restriction to the channels of trade or the types of purchasers in either the application or the

registration. See Canadian Imperial Bank v. Wells Fargo Bank, supra. Therefore, the Board must assume that applicant's services could move through all the ordinary and normal channels of trade for such services, and would be offered to all the usual purchasers (including the general public) for such services. See Octocom Systems Inc. v. Houston Computer Services Inc., supra, at 1787; In re Smith and Mehaffey, 31 USPQ2d 1531 (TTAB 1994); and The Chicago Corp. v. North American Chicago Corp., 20 USPQ2d 1715 (TTAB 1991).

Even if we assume that the purchasers and users of the services in question in the instant case are somewhat careful and sophisticated purchasers, and do not purchase computer consultation services on impulse, this does not mean that such purchasers and users are immune from confusion as to the origin of the respective services, especially when sold under the identical mark. See Weiss Associates Inc. v. HRL Associates Inc., supra; and Aries Systems Corp. v. World Book Inc., 23 USPQ2d 1742, footnote 17 (TTAB 1992).

According to applicant, there have been no instances of actual confusion despite "extensive advertising" (brief, p. 11) by applicant. However, applicant offered no specific information of record regarding its alleged

"extensive advertising," nor of any sales; and there is no information from the registrant. In any event, the test is likelihood of confusion, not actual confusion. See *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984).

While we have no doubt in this case, if there were any doubt on the question of likelihood of confusion, it must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Based on the identity of the marks, the overlapping nature of the parties' respective services, and the similarity of the trade channels and purchasers, we find that there is far more than a mere possibility of confusion; there is a likelihood that the purchasing public would be confused when applicant uses CSA as a mark for its identified computer consultation services.

Decision: The refusal to register under Section 2(d) is affirmed.

R. F. Cissel

T. J. Quinn

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board